

## **REMARKS**

**[0003]** Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. Applicant respectfully requests entry of the amendments herein.

**[0004]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-4, 6-27 and 29-36 are presently pending. Claims amended herein are 1, 3, 4, 6, 7, 12, 15, 16, 19, 27 and 31. Claims withdrawn or cancelled herein are 5 and 28. New claims added herein are none.

### **Statement of Substance of Interview**

**[0005]** Examiner Sangwoo Ahn and his SPE Alam graciously talked with me—the undersigned representative for the Applicant—on July 26, 2007 in the SPE's office in on the third floor of the Knox building at the USPTO in Alexandria, VA.

**[0006]** During the meeting, I reiterated a point that I made previously. That point was put in ¶ 20 of the previous Office Action Response (dated 6/19/2007) and is reproduced here for convenience:

**[0020]** In short, Colson does not disclose use of multiple priority groupings of digital items. Rather, Colson uses priority schemes to sort its entire database of items.

**[0007]** I understood the examiners to interpret Colson to effectively consider each "sorting" of the Colson's entire database to be a different grouping. So, in

effect, the examiners are considering each different sort of a single collection of the same members to be different groupings. I welcome any correction if my understanding is mistaken.

**[0008]** Also, I understood the SPE to look favorably upon the use of the term "tier" (as used in claim 5, for example) rather than the term "groupings" as a way of distinguishing from their above-explained interpretation.

**[0009]** Furthermore, I am unsure that the examiners have fully considered differences between Colson's UI and the UI-based claims (such as claim 12). It appears that the examiners continue to equate the claimed "priority" (i.e., a ranking) with Colson's "priority schemes" (i.e., a formula).

#### **Formal Request for an Interview**

**[0010]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner and his SPE. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0011]** When you call, let's talk about the specific differences, identified herein, between the cited art and the claim recitations.

**[0012]** Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

## **Claim Amendments**

**[0013]** All amendments to claims herein are done merely to clarify merely formal grammatical issues and not to avoid the disclosure of any cited reference.

## **Substantive Matters**

### **Claim Rejections under § 102**

**[0014]** Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

### **Based upon Colson**

**[0015]** The Examiner rejects claims 1-36 under 35 U.S.C. § 102(b) as being anticipated by **Colson**: U.S. Patent Application Publication No. 2002/0078075 by James C. Colson (filed in 12/15/2000).

**[0016]** Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

**[0017]** The Examiner cites **Colson** as its primary reference in its anticipation-based rejections. Colson describes a prioritization system (10) that utilizes a number of predefined prioritization schemes and a collection of scheme effecting data (12) by which the various predefined prioritization schemes may

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<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

be effected. Once a user selects a prioritization scheme from the number of available schemes, the prioritization scheme is preferably stored for use in later requested synchronization or sync sessions.

**[0018]** When the user requests a sync session to synchronize data at a client device (44, 45, 46) with data stored at another designated device, the prioritization system applies the user's selected prioritization scheme along with the required scheme effecting data and any other necessary parameters to produce a prioritized data set. The data at the client device (44, 45, 46) may then be synchronized to the highest priority data as indicated by the prioritized data set.

### **Overview of the Application**

**[0019]** The Application describes a technology facilitates the transfer of a collection of digital items (e.g., a library of music files) from a personal computing device ("PC") to a target device, such as a portable device like a so-called "mp3" player. This technology is particular useful when size of the to-be-transferred library is larger than the storage capacity of the target device. This technology helps automate the decision process involved in selecting a meaningful subset of the library that will actually be transferred to the target device.

**[0020]** The user ranks (i.e., assigns a priority) the digital items in the library. Based upon the assigned user-configurable priorities, the items in the library are sorted into multiple groups, so that the items in each group have like

priorities. In addition, the priority of items in one group differs from the priority of items in the other groups. The sorted items with the highest priority are designated for transfer and synchronization with the target device.

*Independent Claim 1*

[0021] Applicant submits that Colson does not disclose, at least, the following (with emphasis added) from this amended claim:

sorting a collection of digital items stored on a source device and **dividing the collection into multiple tiers** of digital items, wherein **each tier is a subset of the collection** and the items in each tier have like priorities and the priority of items in one tier differs from the priority of items in the other tiers, the sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection;

[0022] To support his position, the Examiner recites the following from Colson (which is reproduced here for the convenience of the reader and with emphasis added):

It will be appreciated that the **prioritization schemes** may be specific to different types of objective data and thus a given scheme may not be enabled for a given type of objective data. (¶[0034], lines 18-21)

Once all the data is retrieved by sync engine component 11, the sync engine component uses the retrieved data to retrieve the proper **prioritization formula** from formula storage arrangement 17 shown in FIG 1. A simple formula to implement the "most used" scheme would order all entries by the frequency with which the entries have been used and within each entry, order the telephone numbers by the frequency with which they have been used. (¶[0049], lines 1-7)

In particular, prioritization program code 52 applies a retrieved **prioritization formula** to the retrieved scheme effecting data and session parameters to produce the **prioritized data set**. (¶ [0030], lines 10-12)

This step produces **a prioritized data set** to which the client device indicated in the sync session request may be synchronized. (¶ [0044], lines 5-7)

[0023] In short, Colson does not disclose use of multiple priority groupings of digital items. Rather, Colson uses priority schemes to sort its entire database of items.

[0024] During our in-person meeting at the USPTO, I understood the examiners to interpret Colson such that each "sorting" of the Colson's entire database to be a different grouping. So, in effect, the examiners are considering each different sort of a single collection of the same members to be different groupings.

[0025] I do not agree with that interpretation. Regardless, I amend this claim herein to clarify it and differentiate it from that interpretation. In particular, this claim is amended to state, "...**dividing the collection into multiple tiers** of digital items, wherein **each tier is a subset of the collection....**" So, the amendment clarifies that the entire collection is divided into multiple tiers and that each tier is a subset of the collection.

[0026] Since Colson only sorts and does not divide its database, this claim differs from it. Since the examiners interpretation of Colson involves its multiple groups being separate sortings of the entire database, this claim differs from Colson because each grouping is not a subset of its database.

[0027] Nothing in the Colson (which is or is not cited by the Examiner) discloses the entire collection is divided into multiple tiers and that each tier is a subset of the collection, as claimed.

[0028] Consequently, Colson does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 2-4 and 6-11*

[0029] These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

*Independent Claim 12*

[0030] Applicant submits that Colson does not disclose, at least, the following from this claim (with emphasis added):

a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, **the collection being divided into multiple tiers**, wherein **each tier is a subset of the collection** and the items in each tier have like priorities for synchronization with a target device coupled to the source device and **one of the tiers having the highest priority amongst the multiple tiers;**

a second display area illustrating a **user-configurable priority** corresponding to the one or more digital items in the listing;

an executable process associated with the one or more digital items in the listing that is configured to:

**designate the tier with highest priority**, wherein the storage requirements of the designated tier of digital items is less than or equal to a defined storage capacity of the target device;

**synchronize the designated tier** of digital items with the coupled target device.

[0031] To support his position, the examiner recites the following from Colson (which is reproduced here for the convenience of the reader and with emphasis added):

As shown at process block 71 in FIG. 3, this information on available **prioritization schemes** is preferably presented graphically to the user using drop-down menus or any other suitable graphical presentation. (¶[0034], lines 16-18)

[0032] In short, Colson does not disclose illustrating a user-configurable "priority" corresponding to listed items. Rather, Colson discloses presenting "prioritization schemes."

[0033] In the previous Action (p. 2), the Examiner summarized, at least, a portion of the Applicant's argument like this:

Applicant mainly stated:

• Colson does not disclose a UI with a "user-configurable priority corresponding to the one or more digital items in the listing." Rather, Colson displays its "priority schemes" that is used to determine the priority.

[0034] Yes, that is correct. Indeed, I maintain that position.

[0035] However, I disagree with equation of terms. In short, a "priority" is not a "scheme" regardless of the fact that "scheme" is modified by the adjective form of "priority." In other words, "priority" does not equal "priority scheme." If they are considered to be same, then one should consider the color "red" and a "red fish" to be one and the same.

[0036] As claimed, a display area illustrates a "user-configurable priority" corresponding to listed items. But, Colson's UI shows "priority schemes." Not the same.

[0037] Furthermore, during our in-person meeting at the USPTO, I understood the examiners to interpret Colson such that each "sorting" of the Colson's entire database to be a different grouping. So, in effect, the examiners are considering each different sort of a single collection of the same members to be different groupings.

[0038] I do not agree with that interpretation. Regardless, I amend this claim herein to clarify it and differentiate it from that interpretation. In particular, this claim is amended to state, "**...the collection being divided into multiple tiers**, wherein **each tier is a subset of the collection....**" So, the amendment clarifies that the entire collection is divided into multiple tiers and that each tier is a subset of the collection.

[0039] Since Colson only sorts and does not divide its database, this claim differs from it. Since the examiners interpretation of Colson involves its multiple

groups being separate sortings of the entire database, this claim differs from Colson because each grouping is not a subset of its database.

[0040] Nothing in the Colson (which is or is not cited by the Examiner) discloses the entire collection is divided into multiple tiers and that each tier is a subset of the collection, as claimed.

[0041] Further still, Colson does not disclose "**designate the tier with highest priority**", "**synchronize the designated tier**", and "...**one of the tiers having the highest priority amongst the multiple tiers....**" As stated above, Colson does not have multiple concurrent tiers. Therefore, necessarily, one tier cannot have a "highest" priority over others.

[0042] Consequently, Colson does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 13-18*

[0043] These claims ultimately depend upon independent claim 12. As discussed above, claim 12 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

*Independent Claim 19*

[0044] Applicant submits that Colson does not disclose, at least, the following (with emphasis added) from this claim:

**dividing the sorted collection** into multiple groups of digital items;

[0045] In short, Colson does not disclose “dividing the sorted collection into multiple groups of digital items.” Rather, Colson merely sorts its entire database of items. Colson never discloses dividing the database into multiple groups.

[0046] During our in-person meeting at the USPTO, I understood the examiners to interpret Colson such that each “sorting” of the Colson’s entire database to be a different grouping. So, in effect, the examiners are considering each different sort of a single collection of the same members to be different groupings.

[0047] I do not agree with that interpretation. Regardless, I amend this claim herein to clarify it and differentiate it from that interpretation. In particular, this claim is amended to state, “...**dividing the sorted collection** into multiple groups...” So, the amendment clarifies that the entire collection is divided into multiple groups.

[0048] Since Colson only sorts and does not divide its database, this claim differs from it. Nothing in the Colson (which is or is not cited by the Examiner) discloses the entire collection is divided into multiple groups, as claimed.

[0049] Consequently, Colson does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 20-26*

[0050] These claims ultimately depend upon independent claim 19. As discussed above, claim 19 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

*Independent Claim 27*

[0051] Applicant submits that Colson does not disclose, at least, the following from this claim (with emphasis added):

a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, **the collection being divided into multiple tiers**, wherein **each tier is a subset of the collection** and the items in each tier have like priorities for synchronization with a target device coupled to the source device and **one of the tiers having the highest priority amongst the multiple tiers**;

a second display area illustrating **a user-configurable priority** corresponding to the one or more digital items in the listing;

[0052] To support his position, the examiner recites the following from Colson (which is reproduced here for the convenience of the reader and with emphasis added):

As shown at process block 71 in FIG. 3, this information on available **prioritization schemes** is preferably presented graphically to the user using drop-down menus or any other suitable graphical presentation. (¶[0034], lines 16-18)

[0053] In short, Colson does not disclose illustrating a user-configurable "priority" corresponding to listed items. Rather, Colson discloses presenting "prioritization schemes."

[0054] In the previous Action (p. 2), the Examiner summarized, at least, a portion of the Applicant's argument like this:

Applicant mainly stated:

• Colson does not disclose a UI with a "user-configurable priority corresponding to the one or more digital items in the listing." Rather, Colson displays its "priority schemes" that is used to determine the priority.

[0055] Yes, that is correct. Indeed, I maintain that position.

[0056] However, I disagree with equation of terms. In short, a "priority" is not a "scheme" regardless of the fact that "scheme" is modified by the adjective form of "priority." In other words, "priority" does not equal "priority scheme." If they are considered to be same, then one should consider the color "red" and a "red fish" to be one and the same.

**[0057]** As claimed, a display area illustrates a "user-configurable priority" corresponding to listed items. But, Colson's UI shows "priority schemes." Not the same.

**[0058]** Furthermore, during our in-person meeting at the USPTO, I understood the examiners to interpret Colson such that each "sorting" of the Colson's entire database to be a different grouping. So, in effect, the examiners are considering each different sort of a single collection of the same members to be different groupings.

**[0059]** I do not agree with that interpretation. Regardless, I amend this claim herein to clarify it and differentiate it from that interpretation. In particular, this claim is amended to state, "**...the collection being divided into multiple tiers, wherein each tier is a subset of the collection....**" So, the amendment clarifies that the entire collection is divided into multiple tiers and that each tier is a subset of the collection.

**[0060]** Since Colson only sorts and does not divide its database, this claim differs from it. Since the examiners interpretation of Colson involves its multiple groups being separate sortings of the entire database, this claim differs from Colson because each grouping is not a subset of its database.

**[0061]** Nothing in the Colson (which is or is not cited by the Examiner) discloses the entire collection is divided into multiple tiers and that each tier is a subset of the collection, as claimed.

[0062] Further still, Colson does not disclose "...**one of the tiers having the highest priority amongst the multiple tiers....**" As stated above, Colson does not have multiple concurrent tiers. Therefore, necessarily, one tier cannot have a "highest" priority over others.

[0063] Consequently, Colson does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 29-30*

[0064] These claims ultimately depend upon independent claim 27. As discussed above, claim 27 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

*Independent Claim 31*

[0065] Applicant submits that Colson does not disclose, at least, the following (with emphasis added) from this claim:

**a sorting-and-dividing means for** sorting a collection of digital items stored on a source device and **dividing the collection into multiple groups** of digital items, wherein the items in each group have like priorities and the priority of items in one group differs from the priority of items in the other groups, the sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection;

[0066] In short, Colson does not disclose "**sorting-and-dividing means for...dividing the collection into multiple groups.**" Rather, Colson merely sorts its entire database of items. Colson never discloses dividing the database into multiple groups.

[0067] During our in-person meeting at the USPTO, I understood the examiners to interpret Colson such that each "sorting" of the Colson's entire database to be a different grouping. So, in effect, the examiners are considering each different sort of a single collection of the same members to be different groupings.

[0068] I do not agree with that interpretation. Regardless, I amend this claim herein to clarify it and differentiate it from that interpretation. In particular, this claim is amended to state, "**...dividing the collection into multiple groups** of digital items ..." So, the amendment clarifies that the entire collection is divided into multiple groups.

[0069] Since Colson only sorts and does not divide its database, this claim differs from it. Nothing in the Colson (which is or is not cited by the Examiner) discloses the entire collection is divided into multiple groups, as claimed.

[0070] Consequently, Colson does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 32-36

**[0071]** These claims ultimately depend upon independent claim 31. As discussed above, claim 31 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Dependent Claims**

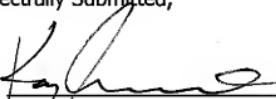
**[0072]** In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

### **Conclusion**

**[0073]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Respectfully Submitted,

Dated: 10-19-07

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